

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. APPLN. NO. 09/855,502
ATTORNEY DOCKET NO. Q64471

REMARKS

Claims 1-11 and 13-16 have been examined on their merits.

The Examiner objects to claims 13 and 16 as being dependent upon a cancelled claim.

Applicants herein amend claim 13 to correct a dependency error. Entry and consideration of the amendment to claim 13 is respectfully requested.

Applicants herein cancel claims 1 and 6 without prejudice and/or disclaimer.

Applicants herein rewrite dependent claims 2 and 7 in independent form, including the recitations of cancelled claims 1 and 6, respectively.

Claims 2-5, 7-11 and 13-16 are all the claims presently pending in the application.

1. Claims 1-11, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berry *et al.* (U.S. Patent No. 6,256,030) in view of Brozowski *et al.* (U.S. Patent No. 6,559,871). The rejection of claims 1 and 6 is now moot due to their cancellation. Applicants respectfully traverse the rejection of claims 2-5, 7-11, 14 and 15 at least for the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837

F.2d 1071, 1074 (Fed. Cir. 1988).

- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Examiner acknowledges that Berry *et al.* do not disclose the association between key lists and each object. See August 8, 2003 Final Office Action, pg. 3. The Examiner argues, however, that Brozowski *et al.* supply the necessary disclosure to overcome the acknowledged deficiencies of Berry *et al.*

The combination of Berry *et al.* and Brozowski *et al.* fails to teach or suggest the comparison of key lists upon receipt of a keyboard event and working through the hierarchical tree structure to find a key within the key lists that corresponds to the keyboard event, as recited in independent claim 2. The combination of Berry *et al.* and Brozowski *et al.* has no teaching whatsoever with respect to key lists being associated with graphical elements, and the key list relationship between parent and child graphical elements, as recited in claim 2. Although the Examiner argues that Brozowski *et al.* disclose the use of keyboard as an input device to designate areas or location on a monitor (see col. 8, lines 48-53 of Brozowski *et al.*), there is no teaching or suggestion in the combination of Berry *et al.* and Brozowski *et al.* that child and parent graphical elements have key lists and that key lists are compared in a hierarchical fashion upon receipt of a keyboard event. For example, the Examiner relies upon Figure 2 as teaching that objects 161 and 162 are children of object 151, but critically, the Examiner has not identified any teaching in Brozowski *et al.* that the actions of the control buttons 172, 173, 174, 175 are controlled via a key list, or that the control buttons 172, 173, 174, 175 are even coupled to key lists. Moreover, the fact that the user interface of Brozowski *et al.* can anticipate future data requests for parent and child objects, and thus initiates its own data requests, is irrelevant. Brozowski *et al.* do not disclose that the “preloaded” parent and child objects are coupled to key

lists, nor do Brozowski *et al.* disclose that the “preloaded” parent and child objects are examined in a hierarchical order upon receipt of a keyboard event. The “data” associated with the parent and child objects are data files that are stored at memory locations graphically represented by the parent and child objects. There is no disclosure in Brozowski *et al.* that the data related to the parent and child objects is used for functional control of a graphical user interface via a keyboard. Thus, Applicants believe that the Examiner has not met the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicants further believe that one of ordinary skill in the art would not have been motivated to combine Berry *et al.* with Brozowski *et al.* The Examiner asserts that one would have been motivated by the alleged tree presentation disclosed by Brozowski *et al.* However, claim 2 recites that child graphical elements inherit the key lists associated with their parent graphical elements, and a received keyboard event is compared with the key lists in a hierarchical fashion until a key that corresponds to the keyboard event is found. Since Brozowski *et al.* lacks any teaching with respect comparison of key lists of child and parent graphical elements with a keyboard event, Applicants submit that one of ordinary skill would not have been motivated to combine Berry *et al.* with Brozowski *et al.* Therefore, Applicants believe that the Examiner has not met the motivation prong of a *prima facie* case of obviousness as well.

Thus, Applicants believe that claim 1 is allowable over the combination of Berry *et al.* and Brozowski *et al.* at least for the reasons set forth above, and further believe that claims 2-5 and 14 are allowable as well, at least by virtue of their dependency from claim 1.

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New independent claim 7 has similar recitations as independent claim 2. Applicants believe that claim 7 is allowable over the combination of Berry *et al.* and Brozowski *et al.* for the same reasons as claim 2, namely the lack of disclosure with respect to the comparison of key lists upon receipt of a keyboard event and working through the hierarchical tree structure to find a key within the key lists that corresponds to the keyboard event. For the sake of brevity, Applicants incorporate by reference the claim 2 arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of obviousness as applying to claim 7 as well. Applicants further believe that claims 8-10 and 15 are allowable as well, at least by virtue of their dependency from claim 7.


Claim 11 has similar recitations as claim 2. Applicants believe that claim 11 is allowable over the combination of Berry *et al.* and Brozowski *et al.* for the same reasons as claim 2, namely the lack of disclosure with respect to the comparison of key lists upon receipt of a keyboard event and working through the hierarchical tree structure to find a key within the key lists that corresponds to the keyboard event. For the sake of brevity, Applicants incorporate by reference the claim 2 arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of obviousness as applying to claim 11 as well. Applicants further believe that claims 13 and 16 are allowable as well, at least by virtue of their dependency from claim 11.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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